REMARKS

In the outstanding Office Action, the Examiner rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Hsuan in view of U.S. Patent No. 6,239,484 to Dore et al. ("Dore"). Applicant proposes herein to amend claim 25. Claims 1, 2, 4-11, 14-18 and 25 are pending in this application, with claim 25 presented for examination.

Applicant initially notes that the Examiner has not returned the PTO Form 1449 submitted with the document cited in the Supplemental Information Disclosure Statement ("Supplemental IDS") filed on September 23, 2003. Applicant respectfully requests that the Examiner consider the document listed in the Supplemental IDS, and indicate that it was considered by making the appropriate notations on PTO Form 1449 submitted with the Supplemental IDS.

Regarding the rejection of claim 25 under 35 U.S.C. § 103(a), Applicant respectfully disagrees with the Examiner's assertions and conclusions as set forth in the outstanding Office Action[1]. Accordingly, Applicant respectfully traverses this rejection because a *prima facie* case of obviousness has not been established. To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. §2143.03, 8th Ed. (Rev. 2), May 2004. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary

[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement of characterization in the Office Action.

skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must "be found in the prior art, and not be based on applicant's disclosure." *See* M.P.E.P. § 2143, 8th Ed. (Rev. 2), May 2004.

Amended claim 25 recites a combination including "a second semiconductor chip stacked on the first semiconductor chip and having a heat radiating plate formed thereon." Nowhere does Hsuan or Dore teach or suggest "a second semiconductor chip ... having a heat radiating plate formed thereon," as recited in claim 25 (emphasis added).

Since Hsuan and Dore whether taken alone or in combination, fail to teach or suggest every element of claim 25, claim 25 is allowable over Hsuan and Dore. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claim 25 under 35 U.S.C. § 103(a).

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claim 25 in condition for allowance. Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 22, 2005

By: 
Darrell D. Kinder, Jr.
Reg. No. 57,460